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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,543	07/03/2003	Mark J. Burzynski	ICUMM1.4CPIRE	1514

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KNOBBE MARTENS OLSON & BEAR LLP  
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IRVINE, CA 92614

EXAMINER
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KOHARSKI, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3763

NOTIFICATION DATE	DELIVERY MODE
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04/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/614,543	<b>Applicant(s)</b> BURZYNSKI ET AL.	
	<b>Examiner</b> CHRISTOPHER D. KOHARSKI	<b>Art Unit</b> 3763	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

The Examiner acknowledges the amendment filed 09/10/2004 in which no claims were amended and new claims 29-66 were added. Currently claims 1-66 are pending for examination in this re-issue application. Additionally, the Examiner also acknowledges the petition granted 08/16/2005 in which the application has been accord Rule 1.47(a) status.

### ***Assignee Consent***

Patentee must provide the assignee's written consent to the re-issue in accordance with 37 CFR 1.172(a). There is no correct assignee consent filed in the case. The current assignment belongs to ICU Medical Sales, Inc. recorded in Reel 01977 at Frame 0033 recorded on 6/25/07. A new assignment to reflect the current assignee is required.

### ***Re-issue Formal Matters/ Claim Compliance***

The amendment filed 09/10/2004 proposes amendments to claim set (addition of new claims 29-66) that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in re-issue applications. A supplemental paper correctly amending the re-issue application is required.

A shortened statutory period for reply to this letter is set to expire ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this letter.

Additionally, there is no compliance with the requirement of 37 CFR 1.173 to point out where there is support for the amendment. Patentee is requested to provide proper support covering the claim scope of the newly added claims.

***Re-issue Oath/Declaration***

The re-issue declaration filed 7/12/05 has failed to properly identify at least one 35 U.S.C.251 error. It is not sufficient for an oath /declaration to merely state “New claims 29, 61, 62, and 63, which broaden the scope of issued claim 1, have been amended to delete the reference to an “internal component hub,” which is consistent with issued claims 17 and 26. The orientations of the internal and external components have also been generalized. New claims 44 and 54 broaden the scopes of original claims 17 and 26, respectively. The orientations of the internal and external components have been similarly generalized in these claims. New claim 64 is a device claim based on new method claim 55, which in turn is based on issued claim 26.”

It appears that Patentee seek to obtain claims having a scope broader than the scope of the claims in the issued patent. The oath /declaration must specifically identify an error. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. (see MPEP 1414 II. (C)). See also *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987).

Additionally, the alleged “internal component hub” cannot be found in the original claim 1. As described above, generalization of terms is insufficient to identify a 251 error, specific claim language is required to correctly identify a 251 error.

***Defective Error Statement, Rejection under 35 U.S.C 251***

The Examiner asserts that the error statement in the oath/declaration regarding the additional claims as filed in the 07/12/2005 has failed to properly identify at least one 35 U.S.C.251 error. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Further since, the re-issue claims broaden the scope of the patented claims (see rejection below) in at least one respect even though they are narrower in other respects. MPEP 1412.03(I), any Supplemental Declaration must be signed by all inventors (not the assignee). See MPEP 1414.01 (III). See also In re Hayes, 53 USPQ 2d 1222.

Claims 1-66 are rejected as being based upon a defective reissue under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See MPEP § 1414.01.

***Recapture, Rejection under 35 U.S.C 251***

Claims 29-66 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present re-issue is based. See Pannu v. Stocz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); Hester

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Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289,295 (Fed. Cir. 1984). A broadening aspect is present in the re-issue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the re-issue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The three step test for recapture is used for as described in MPEP 1412.02. In Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. In North American Container, 415 F.3d at 1349, 75 USPQ2d at 1556, the court restated this test as follows:

We apply the recapture rule as a three-step process:

(1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;

(2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and

(3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

See North American Container, the court cited Pannu, 258 F.3d at 1371, 59 USPQ2d at i600; Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; and Clement, 131 F.3d at 1468, 45 USPQ2d at 1164~65 as cases that lead to, and explain the language in, the North American Container recapture test.

Following this rationale, the prior history of the '574 patent, specifically directed to the amendment filed 10/26/2000, in which Patentee's attorney, Mr. Spaeth specifically argues that he has amended at least claim 1 by adding the limitations regarding "internal component configuration". Patentee's attorney also argued such added limitations are patentable over the art. (See pages 4-7 of the Remarks in the amendment). Subsequently, the previous examiner allowed that application. Currently, the Patentee has presented new claims 29, 61-63 without such limitations. These added limitations in the amendment of 10/26/00 are "surrendered material" that the Patentee is now trying to recapture. This constitutes impermissible recapture.

### ***Conclusion***

The prior art made of record in the original patent has been listed in the attached PTO-892.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 5:30am to 2:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 3/26/2009

/Christopher D Koharski/  
Examiner, Art Unit 3763

/Nicholas D Lucchesi/  
Supervisory Patent Examiner, Art Unit 3763